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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,016	11/24/1999	YAKOV KAMEN	ISURFTV11	5713

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EXAMINER
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SRIVASTAVA, VIVEK

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/449,016	KAMEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Vivek Srivastava	2617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Allowable Subject Matter***

The indicated allowability of claim 1 - 16 is withdrawn in view of the newly discovered reference(s) to Alexander et al. Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 2, 4, 5 and 7 - 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Alexander et al (US 6,177,931).**

***Regarding claims 1 and 11***, Alexander discloses a method comprising displaying a first television program on a TV screen, the TV program comprising a commercial segment. It is noted that TV programs inherently comprise commercial segments. In particular, Alexander discloses a user can access an EPG guide, wherein a real time television program is displayed in a PIP window 12 (see col 3 lines 55 – 61,

fig. 1). Necessarily, Alexander discloses the claimed “displaying a first television program on a video screen” since the PIP window 12 displays real time video for the last channel viewed. Alexander discloses changing the subject matter displayed on the TV by selecting the guide button 35 (fig 2) and displaying the EPG (fig. 1) i.e. information other than the first video program. It is noted that the since TV programs comprise a commercial segment, a viewer can access the EPG during after the TV program and before the commercial segment, which would result in the changing the subject matter displayed on screen since the TV program is no longer shown. Alexander further discloses displaying the previous channel in PIP window, which would now show a commercial segment displayed in the PIP window 12 (fig 1) when the user access the EPG in between the program content segment and the commercial segment. It is noted that Alexander thus discloses the claimed “the video screen comprises a window region continuing to display an indication of the first television program segment simultaneously with a main program screen”. It is further noted that the main program screen displays an EPG which is information other than the television program.

**Regarding claim 2**, as discussed above, Alexander discloses showing a thumbnail commercial in PIP window 12. Necessarily, once the commercial is over, some other content will be displayed in PIP window 12. As a result, Alexander discloses the claimed limitation.

**Claims 4 – 5 and 14** are met by the above.

**Regarding claim 7**, Alexander discloses accessing the internet (see col 13 lines 36 – 45, col 18 lines 33 – 49).

**Regarding claim 8**, Alexander discloses viewing another regularly received television channel on the video screen by selecting another cell on the EPG grid (see col 13 lines 55 – 63, col 3 line 55 – col 4 line 12).

**Regarding claims 9 – 10**, Alexander discloses the link and web page (see col 13 lines 33 – 45).

**Regarding claims 12 – 13**, Alexander discloses transmitting the EPG data in the VBI (see col 11 lines 9 – 43, col 12 lines 1 – 10).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3, 6, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al (US 6,177,931) in view of Berezowski et al (US 6,064,376).**

**Regarding claims 3 and 6**, Alexander discloses a PIP window in the EPG which displays advertising (as discussed above) but fails to disclose the claimed banner advertising products and/or services being advertised during the commercial.

In analogous art, Berezowski teaches an adjustable program guide display which enables adjusting the height of the promotional video information and program guide information to provide the effect desired (see fig 5, col 8 lines 11 - 18). It is noted that the promotional information will be displayed as a banner on top of the EPG when it is desired to show more program listings (see fig 5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berezowski to include an adjustable banner window to maximize the desired effects of the promotional video and guide listings.

**Regarding claims 15 – 16**, Alexander discloses broadcasting information corresponding to a link and a web page (see col 13 lines 37 – 45, col 18 lines 34 – 53) but fails to disclose a clickable banner.

In analogous art, Berezowski teaches an adjustable program guide display which enables adjusting the height of the promotional video information and program guide information to provide the effect desired (see fig 5, col 8 lines 11 - 18). It is noted that the promotional information will be displayed as a banner on top of the EPG when it is desired to show more program listings (see fig 5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berezowski to include an adjustable banner window to maximize the desired effects of the promotional video and guide listings.

The combination of Alexander and Berezowski still fails to disclose the banner is clickable. Official Notice it would have been well known to be able to click on a banner for retrieving additional information. Therefore, it would have been obvious to one

having ordinary skill in the art at the time the invention was made to further modify the combination of Alexander and Berezowski for the benefit of retrieving additional information on the commercial product/service being shown.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Srivastava whose telephone number is (571) 272-7304. The examiner can normally be reached on Monday – Friday from 9 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272 – 7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vs  
9/19/05



VIVEK SRIVASTAVA  
PRIMARY EXAMINER